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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,064	11/17/2003	Michel Gondouin		8865

7590 01/31/2006
Michel Gondouin
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San Rafael, CA 94901

EXAMINER

STEPHENSON, DANIEL P

ART UNIT	PAPER NUMBER
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3672

DATE MAILED: 01/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/716,064	Applicant(s) GONDOUIN, MICHEL	
	Examiner Daniel P. Stephenson	Art Unit 3672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2005.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-23 and 25-27 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 13-23 and 25-27 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 09 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/17/03</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. An examination of this application reveals that applicant is unfamiliar with patent prosecution procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skilled preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

A listing of registered patent attorneys and agents is available on the USPTO Internet web site <http://www.uspto.gov> in the Site Index under "Attorney and Agent Roster." Applicants may also obtain a list of registered patent attorneys and agents located in their area by writing to the Mail Stop OED, Director of the U. S. Patent and Trademark Office, PO Box 1450, Alexandria, VA 22313-1450

Specification

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

3. The abstract of the disclosure is objected to because it exceeds 150 words. Correction is required. See MPEP § 608.01(b).

Drawings

4. The drawings are objected to because the prior art figures have multiple "Figure" numbers and a "Reference" number. The Figures should be labeled using only numerals or a numeral and a letter, i.e. 1, 2, 3, 1A, 2A, 3A, etc. Also, all reference to other patents within a figure should be removed. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

5. The claims 13-23 and 25-28 are objected to because of the following informalities:

The only capital letter in the claim should be the first as each claim is considered to be one sentence. Appropriate correction is required.

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With regards to claims 13 and 15, each of the “means” within the claim should be listed separately for clarity, i.e. “means to connect both said modular elements...”, “means to connect both said elements with a vertical “super-insulated” tubing string...”, “means to connect both said elements with one or more vertical feeder...”, “means to periodically interrupt...” etc. Appropriate correction is required.

With regards to claim 13, the terms “the perforated” on lines 6 and 7 of the claim should be changed to --a perforated--. Appropriate correction is required.

With regards to claim 14, the terms “the cemented” in lines 2 and 3 of the claim should be changed to “a cemented”. Appropriate correction is required.

With regards to claim 19, the term “Generatr” should be --generator--. Appropriate correction is required.

With regards to claim 20, the list presented on lines 8-10 of the claim should be presented in the alternative format, i.e. A, B, C, D or E. Appropriate correction is required.

6. Note that these are only some of the informalities. The claims are replete with these types of informalities and should be carefully considered and examined closely upon amendment in order to make sure that the informalities have been rectified.

Claim Rejections - 35 USC § 112

7. Claims 13-23 and 25-28 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim(s) are replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative

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device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited. The examples below are only some of the errors that render the claims indefinite.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 14, 15, 20-23 have different preambles than the claim they are dependent from.

The preambles of dependent claims should list the same apparatus as the independent claim from which they depend or simply "the apparatus". For example the preamble of claim 15 should either begin --The downhole flow control apparatus of claim 13...-- or --The apparatus of claim 13...--.

Claim 14 appears to be claiming the method of using the apparatus of claim 13, therefore the preamble should read, "The method of using the apparatus of claim 13, the method (including, comprising, consisting of, etc.)..." and then it should recite definite method steps involved in the method of using.

10. Claim 15 recites the limitation "in each lateral well" in the second line of the claim. There is insufficient antecedent basis for a plurality of lateral wells in the claim.

11. Claim 21 is rejected 35 U.S.C. 112, second paragraph, as being indefinite, in that it is a dependent claim that is replacing portions of the preceding independent claim with different limitations. If it is the objective to present a different embodiment of the "super-insulated steam tubular" then a separate independent claim should be utilized with limitations positively recited and not replaced.

12. Claim 23 is rejected 35 U.S.C. 112, second paragraph, as being indefinite for referring to claims from which it does not depend. A claim should only refer to the claim that it is dependent

from. If the applicant wishes to claim limitations from another claim that it is not dependent from then those limitations should be written into the claim in full.

13. The term "much larger" in line 4 of claim 23 is a relative term which renders the claim indefinite. The term "much larger" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

14. With regards to claim 23, it is so indefinite as to preclude examination of the claim based on prior art. Therefore until it is corrected this claim has not been examined with regards to novelty based on prior art.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 13, 15 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gondouin '275 in view of Ellis. Gondouin '275 (Fig. 6, 7, 8A) discloses a downhole flow control apparatus. It consists of various pre-fabricated elements, shipped to and installed on-site from the surface, within the casing and well head of a substantially vertical heavy oil well. The vertical well casing connects to the perforated, nearly horizontal, portion of a liner-equipped lateral well, via a non-perforated, cemented curved part of the liner string of the lateral well. There is a main connecting modular element (Fig. 7), installed by means of a conventional rig.

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This would be broadly read to correspond to the second module of the claims and is located in the casing. There are downhole flow connecting means to connect the modular element with a quasi-horizontal tubing string hung in the lateral well and with the annular space surrounding the horizontal tubing string. There are also means to connect it to a "super-insulated" tubing string. It is noted that since no limitations of what a "super-insulated" tubing string is are present in the claim or specifically defined in the specification using terminology such as "A "super-insulated" tubing string is defined as...", this has been broadly read to include any tubular that would contain a steam flow. The tubular is dedicated to conveying downwards a stream of wet steam from said vertical well's well head to the most distant end of said horizontal tubing string through the module. There are means to connect the module with a vertical "super-insulated" tubing string, dedicated to transporting upwards the hot fluids, produced from the lateral well, to the well head. In addition, there are means to connect both the module with one or more vertical feeder tubing strings. These would be dedicated to transporting downwards a cold stream of oil-lifting fluid, from the vertical well head via the casing annular space around the "super-insulated" tubings. The oil-lifting fluid is a gas-lift fluid. This is usually a water-free mixed light hydrocarbon that is miscible with heavy oil. Downhole flow-interrupting means are provided to periodically interrupt, with surface-operated valves, or with retrievable plugs the respective flow-streams of: a) steam from the surface into the quasi-horizontal tubing string, b) of oil-lifting fluid from the surface into the apparatus, and c) of reservoir fluids produced from the lateral well into the apparatus.

Gondouin '275 does not disclose the "first" module, which is located with the curved part of the liner string. Ellis (Fig. 2) discloses a module attached to a horizontal liner within the curved

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portion of the liner string. It allows for the delivery of fluids to the annulus of the liner as well as the liner string itself. It would have been obvious to one of ordinary skill in the art at the time the invention was made to attach the second module (dual string module) as disclosed in Ellis to the apparatus of Gondouin '275. This would be done to enable the injection and production through one lateral well as shown in the figures of Ellis.

Conclusion

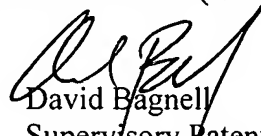
17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Earlougher, Jr., Stout, Cavender et al., Owens et al., Gondouin '751, Dismukes, Hess et al., and the pre-grant publications '657 and '333 to Howard et al. and Ohmer respectively all show similar elements to the present invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel P. Stephenson whose telephone number is (571) 272-7035. The examiner can normally be reached on 8:30 - 5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on (571) 272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


David Bagnell
Supervisory Patent Examiner
Art Unit 3672

DPS *DS*